

### **REMARKS/ARGUMENTS**

Claims 1–28 are pending in the captioned application. Claims 1–13 and 21–27 have been withdrawn as belonging to non-elected restriction groups and/or species. Claims 14–20 and 28 are under examination and have been finally rejected. Applicants hereby cancel non-elected claims 1–13 and 21–27. Applicants reserve the right to prosecute the cancelled claims in one or more divisional applications. Applicants have amended claim 14 and also cancelled claim 28. Applicants submit that in view of the amendments and arguments presented hereinbelow, claims 14–20 are now in allowable form.

The pending claims 14–20 and 28 have again been rejected under 35 U.S.C. § 102(b) and 35 U.S.C. § 102(3). The claims are also rejected under 35 U.S.C. § 112, as containing new matter. Applicants address each of Examiner's rejections in the following sections.

Claims 14–20 and 28 have been rejected under 35 U.S.C. § 112, first paragraph, as containing new matter. The examiner states, "to the extent that the claim no longer requires a "different" amino acid at at least one other specified position in the second set of 6-20 libraries, the increased breadth of possible modification constitutes new matter". In response, Applicants have amended claim 14 to require that the second set of libraries has a different amino acid at the at least one other specified position. Applicants have

also cancelled claim 28. Applicants submit that the amendments rendered the 35 U.S.C. § 112 rejections moot.

Claims 14–17 have again been rejected under 35 U.S.C. § 102(b) as being anticipated by Choo, et al. (WO96/06166). Applicants respectfully disagree. In an effort to further define the claimed invention, applicants have amended claim 14, to clarify that each library of the set of libraries of proteins comprises a mixture of proteins encoded by a single randomized DNA sequence.

Applicants submit that while the current invention claims a method of identifying a protein by providing a set of libraries of proteins, Choo, et al. provides only a single randomized library of DNA sequences which encode a single library of zinc finger proteins (see page 5, line 1 of Choo, et al., also see page 6, second full paragraph of Choo, et al.). Choo does not provide a set of libraries of proteins as claimed by the current invention.

Examiner relies mainly on Figure 4 of Choo, et al. as support of the rejection. Applicants respectfully contend that the Examiner's interpretation of Figure 4 is technically incorrect. The left hand side of Figure 4 shows a column of 33 peptide sequences. These are pre-selected members which have been identified by means of a primary screening process. This is borne out by the text of Choo, et al. which states *inter*

*alia* on page 23, lines 1–6, that “results from these selections are shown in Table 1 (page 23), which lists amino acid sequences of the variant  $\alpha$ -helical regions from clones of library phage selected after 3 rounds of screening with variants of the Zif268 operator.”

The 32 sequences (plus 1 wild type sequence) shown in Figure 4 are contained within the list of sequences of Table 1. Therefore, the list of amino acid sequences of Figure 4 is not a randomized library as argued by the Examiner. It is not even a library. It is a selected list of 33 peptide sequences which cannot be generated by randomization of one or more codons. By contrast the present invention requires in claim 14, (a) (i) the feature that 6-20 libraries of proteins are randomized at at least one other specified position; and in (a) (ii) that 6-20 libraries are randomized at a first specified position. The Applicants contend that the method as claimed in claim 14 (as now amended) is incapable of generating the mixture of peptide sequences as described in Choo, et al. Thus, contrary to the Examiner’s position, the Applicant contends that claim 14, and dependent claims 15-17, are not anticipated by Choo, et al.

Applicants respectfully submit that the 35 U.S.C. § 102(b) rejections can not be sustained and should be withdrawn.

Claims 14–20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Choo, et al. above, further in view of Udenfriend et al. (Anal. Biochem. 1987, 161,

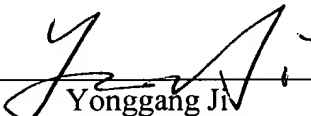
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494-500). Applicants respectfully disagree. Applicants submit that for the reasons stated in the section immediately above (response to the 35 U.S.C. § 102(b) rejection), Choo, et al. does not anticipate or renders obvious claims 14-17. Applicants assert that as such, the combination of Udenfriend, et al. with Choo, et al. does not render obvious claims 18-20. Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections can not be sustained and should be withdrawn.

Early and favorable action is earnestly solicited.

Respectfully submitted,

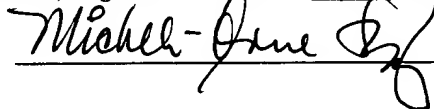
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on July 31, 2006.

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